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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/753,750	11/29/96	LO	R 63637-0102

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HM22/0301

EXAMINER

MINNIFIELD, N

ART UNIT	PAPER NUMBER
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1645

DATE MAILED:

03/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/753,750

Applicant(s)

LO ET AL

Examiner

N. M. Minnifield

Group Art Unit

1645



☒ Responsive to communication(s) filed on Dec 10, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 30-51 is/are pending in the application.

Of the above, claim(s) 42 and 48 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 30-41, 43-47, and 49-51 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☒ Interview Summary, PTO-413 9-28-99

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed December 10, 1999 is acknowledged and has been entered. Claims 30, 40-44 and 46 have been amended. Claims 30-41, 43-47 and 49-51 are now pending in the present application. All rejections have been withdrawn in view of Applicants' amendment with the exception of those discussed below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. It is noted that claims 41 and 45 are being examined with the present invention, nucleic acids. However, claims 42 and 48 have not been examined with the present invention as they are directed to a different invention. Claims 42 and 48 are drawn to assays to detect the claimed nucleic acid and kit containing the nucleic acid. Applicants have argued that the claims are intimately associated the the present invention, are equally patentable and would not require further search.

Applicant's arguments have been fully considered but they are not persuasive. Claims 42 and 48 are directed to a different invention from what Applicants originally elected. Applicants originally elected and has already

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received an Office Action on the product, nucleic acids (claims 30-40, 43, 44, 46 and 47) and a method of use (claims 49-51). Further, the nucleic acids can be used in different methods such as PCR or DNA immunization. Claims 30-41, 43-47 and 49-51 have been examined; restriction is FINAL.

4. The amendment filed February 16, 1999 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: new claims 34 and 35 recite that SEQ ID NO: 1 has 2790 bp and p. 50, lines 6-8 recite SEQ ID NO:1 as having 2790 bp; however the Raw Sequence Listing lists SEQ ID NO: 1 as having 2784 bp. With regard to claim 47, there does not appear to be support for the recitation "organism". Applicants direct the Examiner to two passages in the specification for support (p. 4, l. 12-15; p. 13, l. 11-16). This appears to be the same as claim 37 in which case claim 47 is redundant.

Applicant is required to cancel the new matter in the reply to this Office action.

5. Claims 30-41, 43-47 and 49-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are

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vague and indefinite in the recitation of "hybridize under stringent conditions". These conditions are not set forth in the specification; the metes and bounds are not set forth. The specification states "For example" with regard to the hybridization conditions, but are these the actual conditions.

6. The rejection of claims 30, 31, 33, 43, 44, 46 and 47 under 35 U.S.C. § 102(b) as anticipated by Murphy et al, 1993 is maintained. This rejection is maintained for essentially the same reasons as the rejection of claims 30, 31, 33, 43, 44, 46 and 47 under this statutory provision, as set forth in the last Office action. Applicants' arguments filed December 10, 1999, have been fully considered but they are not deemed to be persuasive. It is noted that the claims are directed to isolated polynucleotide, the claims are not directed to isolated and purified polynucleotide as Applicants are arguing. The specification at page 8 refers to "isolated and purified..." not isolated alone, which appears to^{be} something different. With regard to Murphy et al, 1993 providing no guide on DNA hybridization; it is noted that the claims are directed to isolated polynucleotide which hybridize under stringent conditions to a polynucleotide. Polynucleotide, nucleic acids, encompasses DNA and RNA as Applicants have asserted in the specification. Murphy et al, 1993 discloses hybridization conditions for RNA (i.e. polynucleotide) (p. 2304, col. 1). The prior art discloses the claimed invention.

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Further, polynucleotide primers or probes as set forth in catalogs would meet the limitations of the claimed invention.

7. The rejection of claims 30, 31, 33, ³⁶⁻³⁹~~16-19~~, 43, 44, 46, 47 and 49-51 under 35 U.S.C. § 103 as obvious over Murphy et al, 1993 in view of Schryvers et al, 1992 and further in view of Loosmore et al is maintained. This rejection is maintained for essentially the same reasons as the rejection of claims 30, 31, 33, ³⁶⁻³⁹~~16-19~~, 43, 44, 46, 47 and 49-51 under this statutory provision, as set forth in the last Office action. Applicants' arguments filed December 10, 1999, have been fully considered but they are not deemed to be persuasive. Applicants' arguments with regard to Murphy et al, 1993 have been addressed. Applicants have asserted that neither Schryvers nor Loosmore provide any reasonable expectation of success in isolating the claimed nucleic acid. The prior art references teach the isolation of nucleic acids as previously set forth in the last Office Action.

8. No claims are allowed.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MEP. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

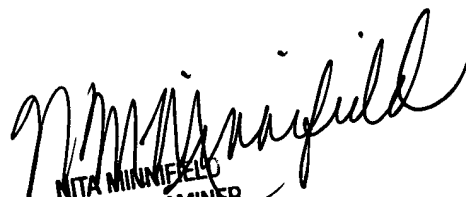
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is (703) 305-3394. The examiner can normally be reached on Monday-Thursday from 7:00 AM-4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached on (703) 308-3995. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

N. M. Minnifield

February 20, 2000


NITA MINNIFIELD
PRIMARY EXAMINER